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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,926	03/31/2004	Andy Schwammburger	ZIM0591	7919
832	7590	11/19/2007		
BAKER & DANIELS LLP 111 E. WAYNE STREET SUITE 800 FORT WAYNE, IN 46802			EXAMINER SHAFFER, RICHARD R	
			ART UNIT	PAPER NUMBER
			3733	
			MAIL DATE	DELIVERY MODE
			11/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/814,926

Applicant(s)

SCHWAMMBERGER ET AL.

Examiner

Richard R. Shaffer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-54,56-62,64 and 67-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-54,56-62,64 and 67-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>WO 03/032849</u> . |

DETAILED ACTION

Claim Rejections - 35 USC § 112

Applicant's claim amendments filed on September 6th, 2007 are acknowledged and accepted by the examiner. The previous 35 U.S.C. 112, first and second paragraph rejections are overcome and are hereby withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 35-38, 40-54, 56, 57, 59, 60, 63 and 64 are rejected under 35 U.S.C. 102(b) as being anticipated by Dall et al (US Patent 5,665,089).

Dall et al disclose (**Figure 8**) a system comprising: a main plate (**81**) with passages (**48**) extending parallel to the plane defined by the main plate; prefabricated elongate flexible connection elements/wire/thread (**64**) pass through the passages (**48**); each connection element is different with respect to shape, size or length (impossible to have perfectly uniform thickness, plus the length will be cut according to different orientations and encircling different anatomies); a flexible (relative term) outrigger (**82**) perforated with a plurality of holes/ring sections adapted to receive at least five (**Column 5, Lines 1-2**) bone screws (**80**); the holes are in a grid-like shape; the outrigger (**82**) has a base area smaller (the thickness along the bone is shorter) than that of the main plate; the device is intended to have the free ends of U-shaped (when

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bent around) wires (64) fixed remote (See Figure 8) from the outrigger (82) and is inherently capable of being twisted or tied instead of crimped; the outrigger and main plate are offset from one another and can have the distance between them controlled by the connection elements (64); the main plate has a hook-like element (the base portion is concave and thus both side edges can be "hooks"); and the outrigger and connection elements when fixed together are unreleasably connected.

Claims 69-71 are rejected under 35 U.S.C. 102(b) as being anticipated by Schumacher et al (US Patent Application 2002/0062127).

Schumacher et al disclose (Figures 1, 2, 7 and 8) an implant comprising: a main plate (14); a plate-shaped monolithic outrigger (64) offset from the main plate; the outrigger (64) including a flexible connection element (70 and 68 together); the flexible connection element (70 and 68) does not extend entirely about the periphery of the bone to be fixed; and the outrigger (64) has "a thickness" (shallow portions within bores 72 or 80) less than a thickness of the main plate (14).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 39, 58, 61, 62, and 67-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dall et al in view of Tassin (WO 03/032849).

Dall et al disclose all of the claimed limitations except for the outrigger and connection element being formed in one piece/integral/monolithic, the "thickness" of the outrigger less than half the "thickness" of the main plate, and the outrigger made of a bioabsorbable material plastically deformable at temperatures between 50 and 90 degrees Celsius.

Tassin teaches (abstract) the use of integrating/forming in one piece/monolithically creating an element for fixation to bone with the connector element to connect to adjacent bone fixators in order to minimize assembly time. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the outrigger and connection element as one piece in order to reduce assembly time. The court has additionally held "that the use of a one piece construction instead of the structure disclosed in the prior art would be merely a matter of obvious engineering choice." See *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965). This limitation would broadly read upon the limitation of the thickness of the outrigger being less than half the thickness of the main plate.

However, in order to maintain a consistent interpretation, it would have further been an obvious matter of design choice to one having ordinary skill in the art at the time the invention was made to have an outrigger with less than five fastening holes and thus have a "thickness" less than half of the main plate since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

In addition, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select a bioabsorbable material which is plastically deformable between the temperatures of 50 and 90 degrees Celsius since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Response to Arguments

Applicant's arguments filed September 6th, 2007 have been fully considered but they are not persuasive. Applicant contends that Dall et al does not disclose the newly added limitation of "the flexible connection element extending less than entirely around the periphery of the bone in the assembled state of the implant." A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Dall et al could, should one desire, fix the wire through the bone instead of completely around it, or extend outward away from one bone and fix to a different plate on a different bone for example. Therefore, Dall et al is capable of the claimed function and therefore anticipates the claimed invention.

Conclusion

Applicant's amendment adding claims 69-71 necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

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See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard R. Shaffer whose telephone number is 571-272-8683. The examiner can normally be reached on Monday-Friday (7am-5pm).

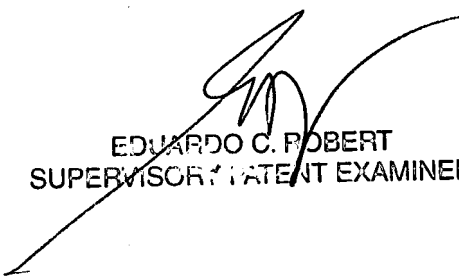
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Richard Shaffer
November 15th, 2007



EDUARDO C. ROBERT
SUPERVISOR / PATENT EXAMINER